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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,131	12/09/2003	Darko Pervan	1033462-000037	3197
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EXAMINER				
KATCHEVES, BASIL S				
ART UNIT		PAPER NUMBER		
3635				
NOTIFICATION DATE		DELIVERY MODE		
08/25/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

### Office Action Summary

**Application No.**

10/730,131

**Applicant(s)**

PERVAN, DARKO

**Examiner**

BASIL KATCHEVES

**Art Unit**

3635

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 7-20 and 25-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 5 and 7-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25 and 27-40 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 3/19/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Claims 1-3, 5 and 7-20 are drawn to an embodiment of fig. 5a and 5b and claims 25 and 26-40 are drawn to the embodiment of figs. 5c and 5d which are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The applicant argues in the remarks of 7/13/09 that these are two species and the applicant has elected figs 5a and 5b which are drawn to the similar boards and not the mirror boards. The applicant reasons that since the mirrored boards were previously examined and since the applicant elects the similar boards, is reasonable to examine both species. The applicant should note that the originally examined claims are drawn to the mirrored embodiment. Even though the applicant now elects the non-examined species, this species (figs. 5a and 5d) are withdrawn by original presentation. The applicant states the examiner has never imposed a restriction however, the restriction is by original presentation to the claims originally examined. The applicant's argument regarding claim 26 is convincing and therefore claim 26 is examined below.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-3, 5 and 7-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 25, 27-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,763,643 to Martensson in view of U.S. Patent No. 2,497,837 to Nelson as in the previous action.**

Regarding claims 25 and 27, Martensson discloses a laminated (fig. 2a, 2b, 2c: 3) rectangular floorboard (fig. 6) with integrated connectors (fig. 8: 2) with a vertical plane between boards when joined with other boards (fig. 8: vertical edge of 3). Martensson also is capable of being locked together by angling the boards together from a generally vertical position. Martensson discloses the basic claim structure of the instant application but does not disclose specific long and short edge dimensions. Nelson discloses a floorboard (title) made from a width less than 10cm (column 2, lines 8-9) and a length less than 80 cm (column 1, lines 49-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martensson by making a board of these dimensions as a design choice in order to fit into particular areas where available space is an important

consideration. Martensson also discloses the boards as having opposing long edges, opposing short edges (fig. 6) and a top layer of a laminate (fig. 8: 1). Also, Martensson discloses a floor made from locked rectangular floorboards (fig. 6) capable of being locked by inward angling (fig. 8: 21, 22) and by laterally sliding panels along joining a mirrored connector 10, the boards, when connected together, create a vertical plane between upper edges (fig. 8: vertical edge of 3 & fig. 2b: 2). Martensson also discloses the boards as connected long side to short side and short side to short side (fig. 6: see T shaped intersection of corners).

Regarding claim 28, Martensson discloses the boards as capable of being joined by inward angling (fig. 8: 21, 22).

Regarding claim 29, claim 29 is rejected for reasons cited in the rejection of claim 27. In addition, Martensson discloses the boards as capable of being joined long side to long side, short side to short side, and long side to short side (fig. 6 and fig. 2b: 4 & 10).

Regarding claim 30, Martensson discloses the boards as being capable of inward locking (fig. 8: see point 22 and groove 21).

Regarding claim 31, Martensson discloses the use of a thermosetting resins for board surface layers (column 2, lines 10-11).

Regarding claim 32, Martensson discloses a flooring system having a plurality of rectangular boards (fig. 6), with integrated connectors that when joined together, their upper edges are on a vertical plane joined together (fig. 2c: 2), the floorboards are capable of connecting in a horizontal direction and a vertical direction with mirror board

edge images (fig 2c). However, Martensson does not disclose specific dimensions of the sides. Nelson discloses a floorboard (title) made from a width less than 10cm (column 2, lines 8-9) and a length less than 80 cm (column 1, lines 49-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martensson by making a board of these dimensions as a design choice in order to fit into particular areas where available space is an important consideration.

Regarding claims 33-38, Martensson discloses the connector as being a separate part, integrated when installed, (fig. 8: 10) which projects beyond the edge and connects with the core portion (fig. 8: 5) of the board. The connector extending from all sides to create a flooring (fig. 6).

Regarding claims 39, 40, Martensson discloses an embodiment (fig. 2c) having, on all sides, two tongues (2, 6) and a groove (4"), the boards being mirror images (figs. 2b and 2c) or mirror inverted (fig. 2a) and aligned along a common line when connected by connector 10', the edges extending longitudinally in parallel directions and in perpendicular directions, those long versus short sides.

### ***Claim Objections***

Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Response to Arguments**

Applicant's arguments filed 7/13/09 have been fully considered but they are not persuasive. Applicant's remarks regarding the restriction by original presentation are addressed above. The applicant argues the dimensions of Nelson do not meet those of the instant application. The applicant argues that Nelson's length greatly exceeds its width. This is not convincing since Nelson states the length greatly exceeds the width (2.5 inches, or 6.35 cm) and a length which greatly exceeds its width may be construed as two or three times its width which would still be less than 80 cm. Regarding the lateral sliding limitation, the applicant should note that Martensson reference may be used in such a manner since its connecting portion extend the length of the board as does the instant application. Regarding the sequence of connecting boards, this is an obvious design choice for assembling a flooring. The applicant argues the method steps of Martensson that there is no suggestion of assembling in the manner of the instant application. The applicant should note that the figures shown by Martensson show an inherent method. As seen in figure 5, Martensson shows locking one panel simultaneously on one edge to a second panel and on an adjacent edge to a third panel. This is not clearly stated by Martensson but it can be seen as obvious in view of the drawings as can be seen that when installing a board in an empty space, it would naturally connect to two adjacent boards. The applicant argues that Martensson teaches identical boards and does not teach mirror inverted edges and points to figs. 1 and 6. The

applicant should note that Martensson teaches different embodiment, some identical and other mirror inverted as fig. 2a shows a mirror inverted edge connector 21 and 22. The applicant argues the reasoning behind the combination of Martensson with Nelson. However, the applicant should note that building materials are often sized to fit particular applications and a mere reduction in size would be common to do. The applicant also argues the previously submitted declaration which has been previously addressed in a prior action.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is



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(571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot, can be reached at (571) 272-6777.

/Basil Katcheves/

Primary Examiner, Art Unit 3635